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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/730,592
Filing Date: December 07, 2000
Appellant(s): FITZPATRICK, JAMES MICHAEL

Richard Neifeld
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 26, 2008 appealing from the Office action mailed May 6, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,972,504	Daniel et al	11-1990
5,873,069	Reuhl et al.	02-1999
6,078,891	Riordan et al.	06-2000

5,918,211	Sloane	06-1999
5,857,175	Day et al.	01-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 45-55 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 40-49, 52 and 55 are directed to a computer program per se or data structure of a computer or software and therefore not statutory under 35 U.S. C. 101. This is exemplified in In re Warmerdam 31 USPQ2d 1754 where the rejection of a claim to a disembodied data structure was affirmed. Thus a claim to a data structure, per se, or other functional descriptive material, including computer programs, per se, is not patent eligible subject matter. Functional descriptive material claimed in combination with an appropriate computer readable medium to enable the functionality to be realized is patent eligible subject matter if it is capable

of producing a useful, concrete and tangible result when used in the computer system. Compare Warmerdam to In re Lowry 32 USPQ2d 1031 where a memory with a data structure that increased computing efficiency was patentable.

The computer readable medium loaded with a computer program and in association with a computer provides the functional descriptive material in usable form to permit the functionality to be realized with the computer. A program product which does not explicitly include such a medium, a program per se, a signal or other type of transmission media that fails to include the hardware necessary to realize the functionality (e.g., a transmitter or a receiver), and a piece of paper with the functional descriptive material written on it are all examples of media which are not believed to enable the functionality to be realized with the computer.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim recites “publishing the price paid database”. It is not clear how a database can be published. Appropriate correction is required.

For examination purposes, the claim will be interpreted as publishing the *content of the* database.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-2, 5-7, 9, 14-16, 18, 23-25, 28-30, 34-36, 40-41, 44, 46, 50-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniel, Jr. et al (US 4972504) in view of Reuhl et al (US 5873069).

Re claims 1, 9, 14, 18, 23-24, 34, 46, 50-51 and 53-55: Daniel teaches a computer-implemented method comprising the steps of: obtaining information from a plurality of retail stores to determine an identification and price paid for purchased items (abstract, col. 6, lines 62-68); recording in a central price-paid database remote from the retail stores at least one of an item identification and the price-paid for each of the purchased items by recurrently obtaining on a predetermined schedule from checkout computers at the retail stores said information about the price paid for purchased items (col. 7, lines 14-45, col. 16, lines 20-55: “*Each such transaction*

may also include data corresponding to the unique identification code of a participating consumer panelist and may also reflect coupon redemptions, sales taxes, ...”).

Daniel does not explicitly teach publishing the *content of the* price-paid database. However, Daniel teaches “producing output reports for customers of the market research” (col. 16, lines 54-55). Reuhl, in the same field of art, teaches publishing the content of a database (col. 9, lines 43-62). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Daniel to include this feature as taught by Reuhl for the obvious reason of generating a report for market research/analysis purposes.

Re claims 2 and 25: Daniel/Reuhl teaches wherein the step of obtaining the information comprises: obtaining customer identification associated with each purchased item (Daniel: col. 19, lines 36-56, col. 7, lines 14-45; Reuhl: col. 7, lines 15-21, 40-55 and col. 10, lines 15-32).

Re claims 5 and 28: Daniel teaches wherein the step of obtaining the information comprises: recording the identification and the price paid for each of the purchased items in the checkout computer; and recurrently uploading the recorded identification and the price-paid to a central computer containing the price-paid database (col. 19, lines 36-56, col. 7, lines 14-34).

Re claims 6, 15, 29, 35 and 44: Daniel does not explicitly teach comparing the price paid to an inventory list price; recording at least one of the inventory list price and a price differential between the inventory list price and the price paid; and recurrently uploading the at least one of the inventory list price and the price differential to the central computer. Reuhl, in the same field

of art, teaches comparing the price paid to an inventory list price; recording at least one of the inventory list price and a price differential between the inventory list price and the price paid; and recurrently uploading the at least one of the inventory list price and the price differential to the central computer (abstract, col. 3, lines 1-67, col. 4, lines 35-60, col. 7, lines 15-21, col. 10, lines 15-35). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Daniel to include these features as taught by Reuhl in order to get the benefit of inventory price comparison with other quoted prices.

Re claims 7, 16, 30 and 36: Daniel further teaches recording at least one of the customer identification and a store identification; and recurrently uploading the at least one of the customer identification and a store identification to the central computer (col. 7, lines 14-34, col. 16, lines 20-55, col. 19, lines 36-56).

Re claims 40, 41 and 52: Daniel teaches storing an item identification corresponding to an item purchased from the plurality of retail stores; storing the price paid for said item purchased; and storing customer identification (col. 7, lines 19-45; col. 19, lines 36-56). Daniel does not explicitly teach the use of fields. However, Reuhl teaches the use of fields (col. 3, lines 5-67, col. 4, lines 35-55 and col. 7, lines 5-25). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Daniel to include plurality of fields because the use of fields in database is well known in the database art for interpreting, processing and storing information in the database.

Claims 8, 10-13, 17, 19-22, 31-33, 37-39, 45 and 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniel, Jr. et al in view of Reuhl et al, and further in view of Riordan (US 6078891)

Re claims 8, 17, 31-32, 37-38 and 45: Daniel does not explicitly teach wherein the step of recording comprises: formatting the price-paid database into columnar entries, wherein the columnar entries include at least one of the customer identification, the store identification, the purchase item identification, the price-paid, the list price, and the price differential. Riordan teaches formatting the price-paid database into columnar entries, wherein the columnar entries include at least one of the customer identification, the store identification, the purchase item identification, the price-paid (columns 7, 9 and 10). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Daniel to include these features as taught by Riordan. Formatting data into columnar entries provides for better understanding of the relationship between the various entries in the database for analytical purposes.

Reuhl teaches list price and the price differential (abstract, col. 3, lines 1-67, col. 4, lines 35-60, col. 7, lines 15-21, col. 10, lines 15-35). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Daniel to include these features as taught by Reuhl in order to compare prices for market research purposes.

Re claims 10-13, 19-22, 33, 39 and 47-49: Daniel does not explicitly teach wherein the step of providing comprises: selecting from the web page price-paid information from at least one of a

store selection, a customer selection, a brand selection, and a sales category selection within a specified district; wherein the step of selecting comprises: determining one of a zip code and an area code of the user; and restricting the specified district to an area within the one of a zip code and an area code; determining one of a remote district, a regional district, and a national district for the user; and restricting the specified district to an area within the one of a remote district, a regional district, and a national district; selecting from the web page price-paid information from stores within a specified district. However, in col. 4, lines 25-45, col. 5, lines 1-15, col. 6, lines 40-65, col. 10, lines 1-15 thereof, Riordan teaches specific data information. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Daniel in view of Reuhl based on the teachings of Riordan for the benefit of price comparison, trends analyses and for market analysis purposes.

Claims 3, 26 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniel, Jr. et al in view of Reuhl et al, and further in view of Sloane (US 5918211)

Re claims 3, 26 and 42: Daniel does not explicitly teach wherein the step of: obtaining customer identification comprises: scanning at least one of a frequent shopper card, a credit card, a club member card, and a debit card. Sloane teaches obtaining customer identification by scanning a frequent shopper card (col. 3, lines 32-46). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Daniel to include this feature as taught by Sloane for the obvious reason of allowing the customer to take advantage of any discount, credits, rewards or promotion contained in the shopper's account.

Claims 4, 27 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniel, Jr. et al in view of Reuhl et al, and further in view of Day et al (US 5857175)

Re claims 4, 27 and 43: Daniel does not explicitly teach wherein the step of obtaining customer identification comprises: scanning at least one of a fingerprint, retinal scan, and a signature. Day teaches identifying a customer using fingerprint scanning (col. 4, lines 25-41). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Daniel to include this feature as taught by Day for the obvious reason of providing alternative means of identifying the customers.

(10) Response to Argument

The Examiner summarizes the various points raised by the Appellant and addresses them individually.

A. Rejection of claim 1 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Regarding independent claim 1, Appellant asserts that the claim is not indefinite as rejected by the Examiner. Appellant's argument is persuasive. This rejection is hereby withdrawn.

B. Rejection of claims 45-55 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

2. As an initial matter, this rejection is intended to be a rejection of claims **40-55** (as recited in the body of the rejection) and not 45-55 as recited in the heading of the rejection. Appellant asserts that the claim is statutory because “database” inherently defines both data and corresponding coding in a computer system. Appellant also asserts that the specification describes essentially what applicant refers to as “database”. However, database is a very broad term and could be construed as a mere printed matter. The claim can be interpreted as a piece of paper having a plurality of fields. The information in the fields are non functional. Examiner notes that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

C. Rejection of claims 1-2, 5-7, 9, 14-16, 18, 23-25, 28-30, 34-36, 40-41, 44, 46 and 50-55 under 35 U.S.C. § 103 (a) as being unpatentable over Daniel, Jr. et al. in view of Reuhl et al.

3. Appellant does not contend that claims **1-4, 24-27, 40-49 and 53-54** are patentable. However, Appellant asserts that claims **5, 14, 28, 50-52 and 55** are patentable over prior art of record. Examiner respectfully disagrees. Specifically appellant asserts that Daniel fails to teach “recording the identification and the price for each of the purchased item in the checkout computer; and recurrently uploading the recorded identification and the price paid to a central

computer containing the price paid database” as recited in claim 5 (claims 14, 28, 50-52 and 55 also having equivalent/similar limitations).

In response, Examiner asserts that Daniel teaches these limitations at col. 7, lines 14-45 and col. 19, lines 36-56.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,
Olabode Akintola
29 September 2007

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